

Amendments to the Drawings

The attached sheet of drawings replaces the original sheet 1.

Attachment: 1 replacement sheet

REMARKS

Thorough examination of the application is sincerely appreciated.

In response to the objection to the drawings, the replacement sheet with the legend "Prior Art" is enclosed herewith. Entry of the revised drawing is respectfully requested.

In response to the objection to the abstract, Applicant attaches a new abstract for entry into the record. Withdrawal of the objection is respectfully requested.

In response to the preferred layout for the specification, it is respectfully submitted that although section headings in the specification are recommended, they are not mandatory. Please see 37 CFR 1.77(b). Therefore, Applicant's representative respectfully declines to insert section headings.

According to the Office Action, claims 1-7 are rejected under 35 USC 101. In response, the rejection is traversed. It is respectfully submitted that independent claims 1-8 recite functional steps of a method, which clearly falls within an enumerated statutory category. It is not clear on what basis it is argued in the Office Action that Applicant's claims are directed to a mathematical algorithm. It appears that Applicant's method claim recitations are analogized to a mathematical algorithm. Applicant's representative is not aware of any court decision that supports such a proposition, and the examiner is respectfully requested to provide legal support. Nowhere do Applicant's claims recite a mathematical algorithm, as incorrectly and without any factual or legal support asserted in the Office Action. Withdrawal of the rejection is requested.

Further according to the Office Action, claims 11 and 12 are rejected under 35 USC 101. In response, without conceding any statements or waiving any arguments in the Office Action Applicant's claims 11 and 12 are canceled without prejudice. The rejection of those claims is, therefore, moot.

Further according to the Office Action, claims 13-17 are rejected under 35 USC 112, second paragraph. In response, without conceding any statements or waiving any arguments in the Office Action Applicant's claims are amended to further clarify the patentable subject matter. Withdrawal of the rejection is respectfully requested.

Further according to the Office Action, claims 1, 5 and 8-10 are rejected under 35 USC 102(e) as being anticipated by US Patent 7,131,007 (hereinafter "Johnston").

Further according to the Office Action, claims 2 – 4 are rejected under 35 USC 103(a) as being obvious over Johnston in view of US Patent 5,401,897 (hereinafter "Depalle").

Further according to the Office Action, claim 6 is rejected under 35 USC 103(a) as being obvious over Johnston in view of US Patent 6,209,094 (hereinafter "Levine").

Further according to the Office Action, claim 7 is rejected under 35 USC 103(a) as being obvious over Johnston in view of Harris.

Further according to the Office Action, claims 11-17 are rejected under 35 USC 103(a) as being obvious over Levine in view of Harris.

In response, the rejections are respectfully traversed as lacking sufficient factual support to establish a prima facie case of anticipation or obviousness in accordance with the established cases and statutory law.

It is asserted in the Office Action that Johnston discloses Applicant's feature of "applying a window shaping function to said sequence of values so as to form a smoothly varying signal suitable for embedding in the host signal" as recited in claim 1. However, the examiner fails to specifically point out where Johnston allegedly discloses this feature. In the Office Action, a reference is made to Harris. However, the rejection is made under 35 USC 102, and even if Harris is applied, the examiner's discussion on "a property of windowing" amounts to a personal

statement of affidavit. The examiner is, therefore, requested to provide such an affidavit, if the rejection is maintained.

The examiner also fails to indicate where Johnston discloses Applicant's feature of "the integral over the window shaping function is zero" as recited in claim 1. In the Office Action, a reference is made to col. 4, line 56 through col. 5, line 24 and col. 8, lines 1-15 of Johnston. However, in the portion of the patent relied upon in the Office Action a signal is transformed into a frequency domain using FFT and then phase modulated. It is not clear how it relates to Applicant's feature, as there is no disclosure in Johnston on the integral over the window shaping function being zero.

If the examiner still believes otherwise and maintains the rejection based on the same prior art reference, he is respectfully requested 1) to **specifically point out** – using column, line numbers and reference numerals/characters – where such a disclosure can be found in Johnston; 2) to provide a personal affidavit stating the facts within his personal knowledge; and/or 3) to provide an affidavit from a skilled artisan stating the same. Once again, the examiner is reminded that in the absence of providing such evidence for Applicant's review and analysis, the rejections can't be properly maintained.

According to the binding case law established by U.S. Court of Appeals for the Federal Circuit and its predecessor Court (as interpreted in Section 2131 of the MPEP), to anticipate a claim, the reference must teach each and every element of that claim. As discussed above, the examiner failed to properly support the anticipation rejections because Johnston is woefully deficient in teaching each and every element of Applicant's claim 1. It is, therefore, respectfully submitted that independent claim 1 is not anticipated by Johnston. Withdrawal of the rejection is respectfully requested, as it cannot be sustained legally.

Independent claim 9 contains similar limitations to claim 1. To avoid repetition, claim 9 will not be discussed in detail with the understanding that it is patentable at least for the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection and allowance of claim 9.

Claims 5, 8 and 10 depend from independent claims, which have been shown to be allowable over the prior art references. Accordingly, claims 5, 8 and 10 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicants submit that the reason for the rejection of claims 5, 8 and 10 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

With respect to claims 2-4, 6 and 7, it is respectfully submitted that the examiner failed to establish a *prima facie* case of obviousness. The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if any one of the above-identified criteria is not met, then the cited references fail to render obvious the claimed invention and the claimed invention is thus distinguishable over the cited references.

According to the Office Action, Depalle, Levine and Harris were only cited to allegedly show features in Applicants' dependent claims, but not relied upon to cure deficiencies in

Johnston with respect to independent claims 1 and 9, as discussed hereinabove. Since Depalle, Levine and Harris, whether alone or in combination, fail to cure the deficiencies in Johnston with respect to the features in independent claims, Applicants' dependent claims 2-4, 6 and 7 are also distinguishable over the prior art of record at least for those reasons, as well as the additional features recited therein. Applicants submit that the reason for the rejection of claims 2-4, 6 and 7 has been overcome and respectfully request withdrawal of the rejection and allowance of the claim.

With respect to claims 11-17, it is respectfully submitted that Harris fails to supplement Levine, as discussed above. Hence, the rejection of claims 11-17 must be withdrawn.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

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